

R E M A R K S

- Claims 3, 6-9, 12-15, 18-20, 22, 34, 38-39, 42-45, 50-51, and 55 were pending in the present application
- Claims 1-53 stand rejected [Please see discussion below]

Upon entry of this amendment, which is respectfully requested for the reasons set forth below:

- Claims 3, 6-9, 12-15, 18-20, 22, 34, 38-39, 42-45, 50-51, and 55 will be pending
- Claims 57 - 61 will be added
- Claims 3, 9, 15, 20, 34, 38, 42-45, 50-51, 55 and 57 - 61 will be the only independent claims

Telephone Interview

Applicants would like to thank the Examiner for the telephone conversation held on February 11, 2003 with Applicants' representative.

The Examiner and Applicants' representative discussed the present invention in light of the Boyer reference. Applicants' representative suggested that Boyer does not teach or suggest features generally directed to:

- *transmitting to the reimbursing party a billing statement for the financial account of the reimbursing party,*
 - *in which the billing statement includes an indication of the second charge amount*
- *determining whether the reimbursing party has remitted a payment of the second charge amount within a predetermined period of time*
- *applying the second charge amount to the financial account of the account holder if the reimbursing party has not remitted a payment of the second charge amount within the predetermined period of time*

as provided in new independent Claims 57-61.

The Examiner and Applicants' representative also discussed a discrepancy between what claims the Examiner indicated are pending (Claims 1-53) and what claims Applicants believe to be pending (Claims 3, 6-9, 12-15, 18-20, 22, 34, 38-39, 42-45, 50-51, and 55). Applicants also stated that it appeared as though Claims 1-53 had been examined as they were originally filed. No agreement was reached as to which claims are pending. The Examiner and Applicants' representative have scheduled a telephone conversation for March 25, 2003 to address the discrepancy.

While no formal agreement was reached, Applicants are grateful for the opportunity to discuss the present application with the Examiner.

Claims 3, 6-9, 12-15, 18-20, 22, 34, 38-39, 42-45, 50-51, and 55 Are Pending

A telephone conversation has been scheduled for March 25, 2003 to clarify which claims are considered as pending. Applicants are grateful for the Examiner's courtesy in scheduling this conversation.

The Office Action (Paper No. 18) indicates that "Claims 1-53" are pending and rejected. However, to the best of Applicants' knowledge, Claims 3, 6-9, 12-15, 18-20, 22, 34, 38-39, 42-45, 50-51, and 55 are pending.

It is apparent to Applicants that in this Office Action the Examiner has examined Claims 1-53 as originally filed on June 16, 1998. The Status of the Office Action Summary (page 1), for example, indicates the Office Action is responsive to communication(s) filed on "06 [sic] June 1998" However, three Amendments have been filed since the application was filed on June 16, 1998: May 25, 2000; October 5, 2000; and August 20, 2001.

[In an Interview Agenda faxed on February 7, 2003, Applicants' representative mistakenly indicated that only Claims 3, 6-9, 12-15, 20, 34, 38-39, 42-45, 50-51, and 55 were pending. Applicants apologize for any further confusion this may have caused.]

Applicants herein discuss pending Claims 3, 6-9, 12-15, 18-20, 22, 34, 38-39, 42-45, 50-51, and 55 in light of the Examiner's comments with respect to originally-filed Claims 1-53, as best understood by Applicants.

Section 103(a) Rejection of Cancelled Claims

Claims 26, 30-33, and 48-49 (as originally filed) stand rejected under 35 U.S.C. 103(a) as being obvious over U.S. Patent No. 6,208,973 issued to Boyer et al. (hereinafter "Boyer"). However, as understood by Applicants, Claims 26, 30-33, and 48-49 were previously cancelled in an Amendment mailed October 5, 2000. Accordingly, the Examiner's Section 103(a) rejection is moot.

Section 102(e) Rejection

Claims 1-25, 27-29, 34-47, and 50-53 (as originally filed) stand rejected under 35 U.S.C. 103(a) as being anticipated by Boyer. Applicants respectfully traverse the Examiner's Section 102(e) rejection.

However, as understood by Applicants, Claims 1-2, 4-5, 10-11, 16-17, 21, 23-25, 27-29, 35-37, 40-41, 46-47, and 52 have been cancelled by Amendments mailed October 5, 2000 and August 8, 2001. Accordingly, the Section 102(e) rejection of the cancelled claims is moot.

Applicants herein discuss Claims 3, 6-9, 12-15, 18-20, 22, 34, 38-39, 42-45, 50-51, and 55, as pending, in light of the Examiner's comments with respect to originally-filed Claims 1-25, 27-29, 34-47, and 50-53, as best understood by Applicants.

1. Independent Claims 3, 9, 15, 20, 34, 38, 42 - 45, 50, 51, and 55

As best understood by Applicants, the Examiner asserts that Boyer discloses all of the features of each of independent Claim 3, 9, 15, 20, 34, 38, 42 - 45, 50, 51, and 55. Applicants respectfully traverse this assertion.

As discussed in the Amendment mailed August 20, 2001, each of independent Claims 3, 9, 15, 20, 34, 38, 42 - 45, 50, 51, and 55 was previously amended to add more detail regarding

how a charge may be processed according to some embodiments of the present invention. Some embodiments of the present invention provide for a reimbursement condition that a particular merchant participates in the transaction. [See, e.g., Specification, page 14, lines 4 - 10.] Each of independent Claims 3, 9, 15, 20, 34, 38, 42 – 45, 50, 51, and 55 provides for wherein a reimbursing party agrees to by having at least a portion of the transaction applied to the reimbursing party's financial account rather than to the account holder's credit card account or debit card account.

Specifically, Claims 3, 9, 15, 20, 34, 38, 42 – 45, 50, 51, and 55 were amended to provide that *charge data indicates a first merchant*, that the step of *determining a reimbursement amount* comprises (i) *determining a reimbursement rule that corresponds to the charge data*, wherein the reimbursement rule specifies a second merchant, and (ii) *determining whether the first merchant corresponds to the second merchant, thereby determining if the charge data satisfies the reimbursement rule*. Whether the charge data satisfies the reimbursement rule is determined by *determining whether the first merchant corresponds to the second merchant*.

Applicants have carefully reviewed the Boyer reference cited by the Examiner, including the particular sections indicated by the Examiner, without finding a teaching or suggestion of a *reimbursement rule that specifies a second merchant*, much less *determining whether a first merchant indicated by charge data corresponds to the second merchant, thereby determining if the charge data satisfies the reimbursement rule*.

Contrary to the Examiner's assertion, Boyer is devoid of any hint or suggestion of "determining whether the first merchant identifier corresponds to the second merchant identifier." [Office Action, page 5.] At the portion of Boyer cited by the Examiner, Boyer merely describes "a product and/or a service code" that may be compared to payment parameters and conditions. [Column 3, lines 39 – 64; Column 4, lines 37 – 48.] Applicants respectfully submit that this description of "a product and/or a service code" refers to an item purchased, and does not teach or suggest reimbursing an account holder for transactions at a specified merchant. Accordingly, Boyer does not teach or suggest *charge data that indicates a first merchant*, or a *reimbursement rule specifying a second merchant*, much less *determining whether charge data satisfies a reimbursement rule based on whether a first merchant corresponds to a second merchant*.

Applicants respectfully submit that Boyer does not disclose all of the limitations of any of independent Claims 3, 9, 15, 20, 34, 38, 42 – 45, 50, 51, and 55. Each of Claims 6-9, 12-14, 18-19, 22, and 39 is dependent from one of independent Claims 3, 9, 15, 20, and 38, and is believed to be allowable for at least the reasons stated herein with respect to the independent Claims 3, 9, 15, 20, and 38.

Accordingly, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of anticipation of any of the pending claims (Claim 3, 6-9, 12-15, 18-20, 22, 34, 38-39, 42-45, 50-51, and 55).

2. Independent Claims 15 and 42 – 43

As best understood by Applicants, the Examiner asserts that Boyer discloses all of the features of independent Claims 15 and 42 – 43. Applicants respectfully traverse this assertion.

In addition to the limitations discussed above, Applicants respectfully submit that Boyer is devoid of a hint or suggestion of *apportioning a transaction amount among a plurality of*

financial accounts, in which each financial account is associated with a respective reimbursing party.

Applicants have carefully reviewed the Boyer reference cited by the Examiner, including the particular sections indicated by the Examiner, without finding a teaching or suggestion of such a feature. At the portion of Boyer cited by the Examiner, Boyer describes only "the first portion of the payment to be paid by the third party payor;" there is no hint or suggestion that more than one reimbursing party may be apportioned any of the transaction amount. [Column 3, lines 39 – 56; Column 4, lines 37 – 48.] In fact, Boyer is directed to "a point of service third party adjudicated payment system" designating "the portion of the service to be paid by the third party payor and the portion to be paid by the customer." [Column 3, lines 8-15.] Applicants respectfully submit that Boyer thus describes a system in which only one entity (the "third party payor" adjudicating the payment) other than the customer pays a portion of the purchase. Accordingly, Boyer does not teach or suggest *apportioning the transaction amount among a plurality of financial accounts, each financial account being associated with a respective reimbursing party*, as provided for in independent Claims **15 and 42 - 43**.

Applicants respectfully submit that Boyer does not disclose all of the limitations of any of independent Claims **15 and 42 – 43**. Accordingly, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of anticipation of any of Claim **15, 18-19, and 42-43**.

3. Claim 6 – 7 and 13 – 14

As best understood by Applicants, the Examiner asserts that Boyer discloses all of the features of each of dependent Claims **6-7, 13-14**, . Applicants respectfully traverse this assertion.

Claims **6 and 13** each provide for applying the same charge amount to both (i) the financial account of the reimbursing party, and (ii) at least one account of the account holder (after a predetermined time). Some embodiments of the present invention provide for determining whether any reimbursing parties have not paid the amounts they were charged. The unpaid amount may then be charged to the corresponding account holder. [See, e.g., Specification, page 27, lines 15 - 23.] Thus, the account holder may be liable, after a predetermined time, for the entire transaction amount (or at least an amount that may have initially been apportioned to a reimbursing party).

Applicants respectfully submit that Boyer is devoid of a hint or suggestion of *applying to at least one of the credit card account and the debit card account a charge amount after a predetermined time after a transaction date*.

Applicants have carefully reviewed the Boyer reference cited by the Examiner, including the particular sections indicated by the Examiner, without finding a teaching or suggestion of such features. Contrary to the Examiner's assertion, Boyer is devoid of any hint or suggestion of "applying to the first financial account the second charge amount after a predetermined time after the transaction date." [Office Action, page 5.] At the portion of Boyer cited by the Examiner, Boyer merely describes problems experienced by healthcare providers because of an inability by the healthcare providers to determine the patient payment amount at the time of service, and the necessity of billing patients while also submitting claims to third party payors for adjudication. [Column 1, lines 16 – 61.]

In contrast, Claims **6 and 13** are directed to methods in an amount to be charged to a reimbursing party is determined, and in which the same charge amount applied to the reimbursing party may also be applied to at least one account of the account holder after a

predetermined time. Further, Claims **7 and 14** provide for wherein the charge amount is applied if the charge amount has not been paid before a predetermined time. There is nothing in Boyer that describes or suggests a need for applying a charge amount to an account holder's account, in which the same charge amount was also applied to a reimbursing party's financial account.

Applicants respectfully submit that Boyer does not disclose all of the limitations of any of Claims **6 – 7 and 13 - 14**. Accordingly, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of anticipation of any of Claim **6 – 7 and 13 - 14**.

For at least the reasons stated herein, Applicants respectfully submit that all of the pending claims (Claims **3, 6–9, 12–15, 18–20, 22, 34, 38–39, 42–45, 50–51, and 55**) contain allowable subject matter.

Newly-Added Claims 57 - 61 Are Patentable Over the Cited Reference

Newly-added Claims 57 - 61 are patentable over Boyer for at least the reasons presented herein.

As discussed above, Boyer does not teach or suggest applying the same charge amount to a financial account of an account holder that was billed to a financial account of a reimbursing party, much less applying such a charge amount if the reimbursement party has not remitted a payment for the second charge amount within a predetermined period of time. Specifically, Boyer does not teach or suggest any of the following:

- *transmitting to the reimbursing party a billing statement for the financial account of the reimbursing party,*
 - *in which the billing statement includes an indication of the second charge amount*
- *determining whether the reimbursing party has remitted a payment of the second charge amount within a predetermined period of time*
- *applying the second charge amount to the financial account of the account holder if the reimbursing party has not remitted a payment of the second charge amount within the predetermined period of time*

as generally provided in new independent Claims 57 - 61.

Independent Claims 57 – 60 each provide for *determining a reimbursement rule that is associated with a credit card or a debit card account, in which the reimbursement rule indicates a period of time for the reimbursing party to remit payment*. Boyer does not teach or suggest such a feature.

Further, independent Claims 59 and 60 each provide for *determining whether the charge data satisfies the reimbursement rule based on the reimbursement condition and the indication of a category of merchant*. Boyer does not teach or suggest such a feature.

For the reasons stated herein, Applicants respectfully submit that new Claims 57 - 61 contain allowable subject matter.

Conclusion

It is submitted that all of the claims are in condition for allowance. The Examiner's early re-examination and reconsideration are respectfully requested.

Please charge any fees that may be required for this Amendment to Deposit Account No. 50-0271. Furthermore, should an extension of time be required, please grant any extension of time which may be required to make this Amendment timely, and please charge any fee for such an extension to Deposit Account No. 50-0271.

If the Examiner has any questions regarding this amendment or the present application, the Examiner is cordially requested to contact Michael Downs at telephone number (203) 461-7292 or via electronic mail at mdowns@walkerdigital.com.


Petition for Extension of Time to Respond

Applicants hereby petition for a one-month extension of time with which to respond to the Office Action. Please charge \$55.00 for this petition to our Deposit Account No. 50-0271. Please charge any additional fees that may be required for this Response, or credit any overpayment to Deposit Account No. 50-0271.

If an additional extension of time is required, please grant a petition for that extension of time which is required to make this Response timely, and please charge any fee for such extension to Deposit Account No. 50-0271.

Respectfully submitted,

March 14, 2003
Date


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